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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,926	02/07/2005	Jan van Walraven	WALRAVEN3	1885
1444	7590	12/01/2006	EXAMINER DUMAS, NKEISHA J	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			ART UNIT 3632	PAPER NUMBER

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/523,926

Applicant(s)

VAN WALRAVEN, JAN

Examiner

Nkeisha J. Dumas, Esq.

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-43 is/are pending in the application.
- 4a) Of the above claim(s) 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-23 and 28-42 is/are rejected.
- 7) ☒ Claim(s) 24-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/7/2005 and 6/10/2005</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The following correspondence is a non-final Office Action for application number 10/523,926, for a VIBRATION ISOLATING PIPE CLIP, filed on 2/7/2005. Claims 1-20 have been cancelled. Claims 21-43 are pending. Claim 43 is withdrawn pursuant to a restriction requirement.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 21-42, drawn to a vibration isolating pipe clip, classified in class 248, subclass 55.

II. Claim 43, drawn to a roll of porous material, classified in class 428.

3. Inventions I and II are directed to related material. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have materially different modes of operation, functions and effects. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Sheridan Neimark on 11/07/2006 a provisional election was made with traverse to prosecute the invention of the pipe clip, claims 21-42. Affirmation of this election must be made by applicant in replying to this Office action. Claim 43 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Priority***

6. Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on a PCT application filed at the European Patent Office in Munich on 8/4/2003. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of such foreign application. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

***Information Disclosure Statement***

7. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

***Drawings***

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the

description: reference number 2, on page 10, line 14. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

9. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

#### ***Specification***

10. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly

those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

11. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

12. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### ***Claim Objections***

13. Claims 24-27 are objected to as dependent on a cancelled claim. Accordingly, these claims have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

14. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15. Claims 37-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

invention. Beginning at page 12, line 20 of the specification, the applicant discloses that an alternate embodiment of the invention allows the retaining edges of the vibration isolating member to interact in a positively locking manner with the pipe clip body, however, this embodiment is not shown. It is unclear how the applicant intends to accomplish this limitation.

16. Further, applicant describes that the retaining edges have a less porous structure than the intervening porous strip, however, applicant has not described or shown an intervening porous strip in the specification or drawings.

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 21, 33, 35, 36 and 38-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

19. Claim 21 recites the limitation "the inner circumference" in line 9, and "the outer circumference" in line 10. There is insufficient antecedent basis for these limitations in the claim.

20. Regarding claims 33 and 35, these claims are indefinite because applicant merely recites the method limitation of "cleaving off water from a water-containing chemical." It is unnecessary to find this method in order to determine the final product, and therefore, only the product made from this method is considered.

21. Claim 36 recites the limitation "the annular body" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.



22. Claim 38 recites the limitation "the side edges" in line 3. There is insufficient antecedent basis for this limitation in these claims.

23. Regarding claims 38 and 39, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

24. Claims 39 and 40 recite the limitation "the intervening porous strip" in lines 2-3, respectively. There is insufficient antecedent basis for this limitation in these claims. The scope of these claims can not be determined and therefore they are not rejected based on prior art references.

25. Regarding claim 41, this claim is indefinite because applicant recites the desired result with no specific product or structure to attain. The scope of the claim can not be determined and therefore it is not rejected based on prior art references.

***Claim Rejections - 35 USC § 103***

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 21-23, 28-38 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerster (U.S. Pat. 5,947,425) in view of van Walraven (EP 1,106,900A1).

Regarding claims 21 and 42, Gerster teaches a vibration isolating pipe clip or member (10) comprising a rigid pipe clip body (20) which is composed of one or more

parts and is provided with securing means (7), a vibration isolating member (14, 24) which bears against an inner circumference of the pipe clip body and is ultimately positioned between an outer circumference of the pipe and the pipe clip body (Figs. 1 and 2), wherein the vibration isolating member is made from porous vulcanized rubber (col. 3, lines 30-38), but, Gerster does not teach the rubber with closed cavities and separating walls between them. Van Walraven, however, teaches a pipe clip with a vibration isolating member having pores and a closed cell structure (col. 1, lines 47-51), *i.e.*, closed cavities and separating walls, for elastic resilience. It would have been obvious to one of ordinary skill in the art to make the vibration isolating member of the pipe clip with closed cavities and separating walls between them to strengthen the member and further enhance its sound and shock absorbing capabilities.

Regarding claim 22, Gerster and van Walraven teach the pipe clip of claim 21, where van Walraven teaches that the walls have a thickness and the cavities have a diameter which are such that elastic deformation of the vibration isolating member takes place under elastic deformation of the walls, with the volume of the cavities being reduced (col. 2, lines 3-20).

Regarding claim 23, Gerster and van Walraven teach the pipe clip of claim 21, where Gerster and van Walraven teach, by the use of vulcanized rubber for its sound and shock absorbing capacities, that the walls have a thickness which is such that in the event of elastic deformation of the vibration isolating member the intervening walls have a deformation behavior which substantially corresponds to the deformation behavior of solid rubber.

Regarding claims 28-32, Gerster and van Walraven teach the pipe clip of claim 21, but do not teach the specific dimensions of the form factor, thickness of the intervening walls and diameter and number of cavities. Gerster and van Walraven, however, teach the use of vulcanized rubber for its sound and shock absorbing capacities. Thus, it would have been an obvious design choice to one of ordinary skill in the art to manufacture the porous vulcanized rubber with the specific dimensions of the form factor, thickness of the intervening walls and diameter and number of cavities in order to create a material that accepts deformations under load and to quickly recover its original dimensions once the load is removed because vulcanized rubber is well known in the art for its sound absorbing characteristics, strength, and durability.

Regarding claim 33, applicant sets forth method step limitations, however, only the finished product is considered. As indicated above, the product of claim 21 is met by Gerster in view of van Walraven.

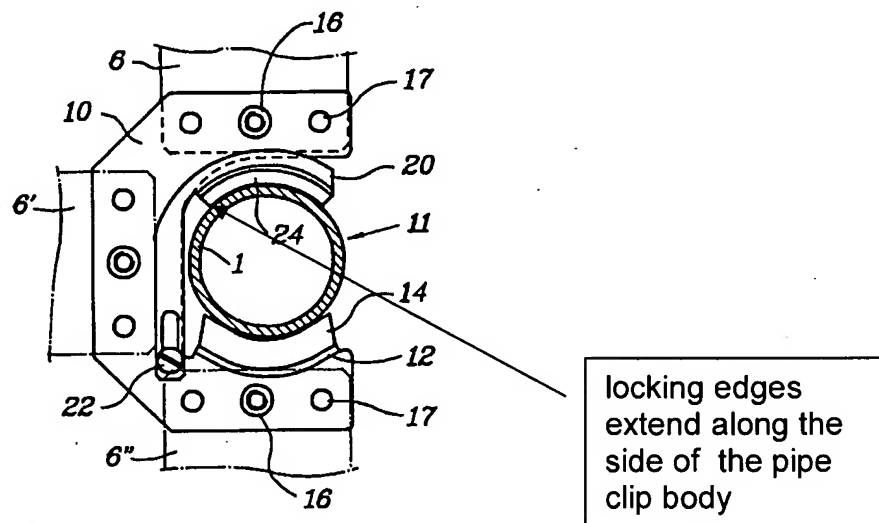
Regarding claim 34, Gerster and van Walraven teach the pipe clip of claim 21, but do not teach that the material of the porous vibration isolating member is selected from the group of EPDM polymers. Gerster and van Walraven, however, teach the use of vulcanized rubber for its sound and shock absorbing capacities. Therefore, it would have been obvious to one of ordinary skill in the art to select the material of the porous vibration isolating member from the group of EPDM polymers because such material is commonly used for manufacturing synthetic rubber through the vulcanization process in construction applications.

Regarding claim 35, applicant sets forth method step limitations, however, only the finished product is considered. As indicated above, the product of claim 33 is met by Gerster in view of van Walraven.

Regarding claim 36, Gerster and van Walraven teach the pipe clip of claim 21, where van Walraven teaches that the vibration isolating member has an elongate strip-like body which extends along an inner circumference (Figs. 1-4).

Regarding claims 37 and 38, Gerster and van Walraven teach the pipe clip of claim 36, and, as best understood Gerster teaches that the vibration isolating member is provided with retaining edges that extend along the side edges of the pipe clip body and interact with the pipe clip body in a positively locking manner (Fig. 2) (see below).

**Fig. 2**



### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nkeisha J. Dumas, Esq. whose telephone number is

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(571) 272-5781. The examiner can normally be reached on Monday - Friday, 8:30 a.m.  
- 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
njd

  
Carl D. Friedman  
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Group 3600